

REMARKS

The amendment to Claim 11 seeks to correct an inconsistency between its recitation and that of Claim 1 from which Claim 11 depends.

The present invention is directed to a phosphorous compound conforming to a recited structure, a thermoplastic composition containing the same and an article molded of the composition.

Claims 1-5 and 7-18 stand rejected under 35 U.S.C. 112 first paragraph the Examiner contending that these claims "contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventor(s), at the time the application was filed had possession of the claimed invention. There is no antecedent basis for the newly claimed C₇-C₂₀ alkyl range."

The range at issue pertains to the identity of certain radicals, R¹ and R² featured in the claimed structure. As originally disclosed and claimed, these were identified as, among others, "C₁₋₂₀-alkyl, cycloalkyl or aryl".

At issue is whether or not the inventors were at the time the application was filed in possession of the invention entailing the presently claimed range.

Applicants respectfully assert that the inventors were in fact in such possession.

In the specification (page 3, line 6) the relevant disclosures recite

"each containing 1 to 20 carbon atoms".

This disclosure is understood by the art-skilled to be shorthand for

"each containing 1 or 2 or 3 or 4 or 5 or 6 or 7 or 8 or 9 or 10 or 11 or 12 or 13 or 14 or 15 or 16 or 17 or 18 or 19 or 20 carbon atoms."

Applicants respectfully submit that this construction of the original disclosure is the only reasonable one and as such supports the range of C₇₋₂₀. The Examiner is

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requested to provide another conflicting construction if such in fact exists.

Relying on the original disclosure and faced with close prior art, the Applicants found it necessary in the course of prosecution to restrict the scope of the protection to the presently claimed range.

The case of In re Johnson, 194 USPQ 187, 195-96 (CCPA 1977), clearly supports Applicants' position that they may decide what bounds of protection they will seek and that they may retreat to otherwise patentable subject matter because only part of what was originally claimed is patentable.


Claims 1, 5, 8, and 11 stand rejected under 35 U.S.C. 102(a) as anticipated by Bayer WO 99/07782 or Bayer's WO 00/31173.

In their amended form that recite the range at issue the claims are believed to avoid the cited art and be patentable there over.

Believing the above represent a complete response to the Office Action and that the application is in condition for allowance, Applicants request the earliest issuance of an indication to this effect.

Respectfully submitted

By


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